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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,702	09/13/2005	Jorg Thielen	23169	7287

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EXAMINER

MATTER, KRISTEN CLARETTE

ART UNIT	PAPER NUMBER
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3771

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/519,702

Applicant(s)

THIELEN ET AL.

Examiner

Kristen C. Matter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) 17,18,20,21 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the closed front end, open rear end, skirt, and openable flap must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 6a and 6b.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "7" has been used to designate both condom and sheath.

Furthermore, no element in the drawings should be labeled with descriptive matter. Please see the attached Notice of Draftsperson's Patent Drawing Review (Form PTO-948) for further objections to the drawings.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The disclosure is objected to because of the following informalities:

- On page 3, line 22, examiner is unsure what a "hardenable mas" is describing. If "hardenable mas" is replaced with "hardenable mass", further description is still needed to clearly describe the subject matter.
- On page 6, line 2, "device" should be replaced with "devices".
- On page 6, line 3, "...that vibratory device..." should be replaced with "...that the vibratory devices..."
- On page 6, line 12, "movements" should be replaced with "movement".
- On page 6, line 15, "vibration" should be replaced with "vibrations".
- On page 7, line 3, "...dependent of..." should be replaced with "...dependent on..."
- On page 7, line 19, "drawing" should be replaced with "drawings".

Appropriate correction is required.

***Claim Objections***

Claims 17, 18, 20, 21, and 24 are objected to because of the following informalities: They refer to a “closed front end”. Throughout with specification and drawings, reference is made to an “outer end”. Consistent terminology should be used for clarity. Appropriate correction is required.

Furthermore, in claim 21, “a thin-walled, flexible, and tubular skirt” should be changed to “a thin-walled, flexible, tubular skirt”. As currently written, “a thin-walled, flexible, and tubular skirt” appears to define three (3) separate skirts instead of one thin-walled, flexible, tubular skirt. Appropriate correction is required.

Claim 27 is objected to because of the following informalities:

The location on the sheath for the “ring having a thickened region” is unclear as currently written. As written it may appear a second sheath is added at the open rear end of the first sheath for the second vibratory drive to be imbedded. Examiner suggestion: On line 2, “at the open rear end” should be moved to line 3 immediately following the word “imbedded” to clearly identify where the “ring having a thickened region” is located on the sheath.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 20, applicant describes a closed front end of a sheath formed "rearward of the drive" followed by a rearwardly open reservoir. This seems to place the drive on the front-most portion of the vibrator, however, according to independent claim 17, the drive is imbedded in the sheath, not located adjacent to it.

Regarding claims 21 and 22, use of the term "skirt" fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Thorough reading of the specifications and drawings does not describe what the term "skirt" corresponds to, which renders the term vague and indefinite in the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfeil (US 5,377,692). Pfeil teaches a vibrating condom having a vibrating portion, in which the condom (sheath) may be molded or extruded with the vibratory portion as a unitary member (see column 3, lines 35-40). Furthermore, the electrical power source to the vibrating condom may be

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embedded into the vibrating region (see column 4, lines 19-22) and may be driven by any type of energy source (i.e., battery) and have controls to vary the amplitude of the oscillations (see column 3, lines 45-55).

Regarding claim 17, Pfeil does not teach specifics on the switch, however, it would have been obvious to one of ordinary skill in the art at the time the invention was filed to have made the controls taught by Pfeil a switch imbedded in the sheath for convenient control of an imbedded vibratory drive in the condom.

Regarding claim 18, Pfeil does not teach the vibratory drive in a closed front end of a sheath. However, Figure 1 teaches the vibratory portion extending up a length of a condom towards a front closed end. The applicant only discloses the vibrator as being able to extend over the at least tip of a penis and gives no criticality to the location of the vibratory drive being completely contained within the closed open end for stimulating the male. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was filed to have moved the vibratory portion of Pfeil's invention to the closed front end of the condom or to any location on the condom for producing vibrations that stimulate the male. Furthermore, regardless of where the vibratory drive is placed, due to the size and material of such inventions, the entire sheath will vibrate, producing the same effect.

Regarding claim 19, Pfeil teaches the sheath centered on a longitudinal axis with a rearwardly open cavity (see Figure 1).

Regarding claim 23, Pfeil does not teach a separate condom fittable over the sheath. However, it would have been obvious to one of ordinary skill in the art at the time the invention

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was filed to have placed a second condom over the vibrating condom taught by Pfeil for sanitary or safety purposes.

Regarding claim 24, Pfeil teaches a condom sheath with a closed front end.

Regarding claim 25, Pfeil does not teach an openable flap on the sheath for accessing batteries. However, it would have been obvious to one of ordinary skill in the art at the time the invention was filed to have a flap for accessing batteries in any instrument that uses batteries as a power source and is not for single-use.

Regarding claims 26 and 27, Pfeil does not teach a second vibratory drive adjacent the open end of the sheath, particularly in a thickened ring. However, Pfeil does teach a thickened ring as included with the vibratory portion for stimulating the female organ (see Figure 1). The applicant gives no criticality to having multiple vibratory drives in the specifications other than for stimulating the female clitoris. Given that Pfeil's condom accomplishes the same stimulation, and the applicant does not disclose independent operation of the drives, the addition of a second drive at the open end of the sheath, particularly in a thickened ring, is considered duplication and therefore a prima facie case of obviousness.



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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen C. Matter whose telephone number is (571) 272-4794. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Henry Bennett  
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